

REMARKS

In the present amendment, Applicants have canceled claims 1-17 without prejudice or disclaimer and added new claims 18-24. Thus, new claims 18-24 are pending. New claims 18-24 in the present specification are identical to non-elected claims 18-24 in related, co-pending U.S. Application No. 10/229,390, assigned to the present Examiner, with the exception that a typographical error has been corrected in claim 23. (The first occurrence of the word "mutagenized" was spelled incorrectly.) As discussed in the Preliminary Amendment filed August 30, 2002, in U.S. Application No. 10/229,390, new claims 18-24 are supported by the present specification as follows:

Claim 18 is similar to claim 1 of U.S. Application No. 09/274,383, now issued as U.S. Patent No. 6,391,548, to which the present application claims priority. Claim 18 differs from issued claim 1 in two ways. First, issued claim 1 contained typographical errors, which have been corrected in claim 18. The word "strand" was erroneously omitted from issued claim 1. The issued claim also contained a superfluous "wherein" clause that did not add any additional limitation. (Applicants discussed that error in the Request for a Certificate of Correction, which was filed on August 9, 2002, in U.S. Application No. 09/274,383.) Those errors are corrected in claim 18 of the present application. In addition, the word "said" has been replaced with the word "the" for consistency.

Second, claim 18 does not contain the phrase, "digesting said DNA molecule for mutagenesis, wherein said digestion is mediated by a selection enzyme." Support for claim 18 can be found in the specification, e.g., at page 4, lines 12 to 21.

Claims 19, 20, 21, 22, and 23 of the present application are identical to issued claims 7, 8, 9, 10, and 11 of U.S. Application No. 09/274,383, respectively, except that

they depend from new claim 18. The word "said" in claim 23 has been replaced with the word "the" for consistency.

Claim 24 is similar to claim 18 of this application. Claim 24 further recites "digesting the DNA molecule for mutagenesis, wherein the digestion occurs *in vivo*." Support for claim 24 can be found throughout the specification, for example, at page 2, lines 9-26.

No new matter is added by the foregoing amendments.

I. Objection to the Specification

The Examiner objected to the specification, stating that "the continuation information must be updated to reflect issuance of the parent '652 application as U.S. Patent No. 6,713,285." Office Action at page 2, item 1. In the present amendment, Applicants have amended the specification to update the continuation information as directed by the Examiner. Withdrawal of the objection to the specification is respectfully requested.

II. Rejection of Claims 1-11 and 13-17 Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-11 and 13-17 as allegedly being indefinite. Office Action at page 2, item 2. Specifically, the Examiner alleged that "[c]laims 1-11 are confusing because of apparent incomplete language in the 'annealing' step of claim 1...." *Id.*, item 2, part A. The Examiner further alleged that "[c]laims 13-17 are confusing because claims 13, 14, and 17 depend from themselves." *Id.*, item 2, part B.

In the present amendment, Applicants have canceled claims 1-17. Thus, the rejection is rendered moot. Withdrawal of the rejection of claims 1-11 and 13-17 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

III. Rejection of Claims 1-17 Under 35 U.S.C. § 101

The Examiner rejected claims 1-17 under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-17 of prior U.S. Patent No. 6,391,548. Office Action at pages 2-3, item 3. In the present amendment, Applicants have canceled claims 1-17. Thus, the rejection is rendered moot. Withdrawal of the rejection of claims 1-17 under 35 U.S.C. § 101 is respectfully requested.

IV. Rejections Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner imposed the following claim rejections under the judicially created doctrine of obviousness-type double patenting:

1. Claims 1-17 were rejected as allegedly being unpatentable over claims 1-5 of U.S. Patent No. 5,789,166. Office Action at page 3, item 4.

2. Claims 1-11 were rejected as allegedly being unpatentable over claims 1-7 of U.S. Patent No. 5,932,419. Office Action at page 4, item 5.

3. Claims 1-17 were rejected as allegedly being unpatentable over claims 3-12 of U.S. Patent No. 6,713,285. Office Action at page 4, item 6.

4. Claims 1-11 were provisionally rejected as allegedly being unpatentable over claims 18-24 of copending U.S. Application No. 10/229,390. Office Action at page 4, item 7.

In the present amendment, Applicants have canceled claims 1-17. Thus, the above rejections are rendered moot as to those claims. If new claims 18-24 are otherwise allowable, Applicants will file a terminal disclaimer should the Examiner reject those claims under the judicially created doctrine of obviousness-type double patenting.

Withdrawal of the above claim rejections under the judicially created doctrine of obviousness-type double patenting is respectfully requested.

CONCLUSION

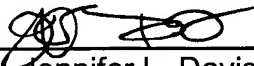
Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. In the event that the Examiner does not find the claims allowable, Applicants request that the Examiner contact the undersigned at (650) 849-6778 to set up an interview.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 10, 2005

By: 
Jennifer L. Davis
Reg. No. 54,632
Customer No. 22,852